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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/224,620 12/31/98 MARISSETTY

S 42390.P2319R

EXAMINER

TM02/1009

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ALIVE, S
ART UNIT PAPER NUMBER

2181
DATE MAILED:

10/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/224,620

Applicant(s)

MARISSETTY, SURESH K.

Examiner

Glenn A. Auve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 51-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 51-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. In light of the Court of Appeals for the Federal Circuit's recent decision in Pannu v. Storz Instruments, Inc., 59 USPQ2d 1597 (Fed. Cir. 2001) the issue of recapture has been reconsidered. As a result of this reconsideration it has been determined once again that recapture does apply to this case and an appropriate rejection is set forth below.

Reissue Applications

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

While applicant has generally referred to "excess limitations" there is no indication as to what those excess limitations are. In identifying the error it is sufficient to identify a single word, phrase, or expression in the specification or an original claim, and how it renders the original patent to be wholly or partly inoperative or invalid. The declaration must specifically identify an error. (see MPEP § 1414)

Also, there is no new oath in the case to cover the amendments made on April 4, 2001.

3. Claims 1-35 and 51-94 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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4. Applicant has stated in the remarks filed July 3, 2001, that the original patent is lost. This statement as to the loss or inaccessibility of the original patent is accepted as the required declaration regarding loss of the patent.

5. Claims 51-94 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As has been previously stated in this case, the newly presented reissue claims omit the "virtual device driver" limitation which applicant argued in the parent patent made the claims allowable. Applicant has gone to great lengths to argue that even if the omission of the "virtual device driver" limitation makes the claims broader in an aspect germane to the prior art rejection that the newly added limitations at the same time make the claims narrower in an aspect germane to the prior art rejection, and that because of this the recapture rule is avoided. However, the Federal Circuit in *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597 (Fed. Cir. 2001) addressed a similar situation in which the limitation that was added during the prosecution of the original patent to make the claims allowable was omitted in the new reissue claims but

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those reissue claims also contained further limitations which Pannu argued narrowed the scope of the claims in a way related to what was surrendered. The court concluded that on reissue, Pannu was estopped from attempting to recapture the precise limitation he added to overcome the prior art rejections. The court also pointed to their decision in *Anderson v Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998).

Taking claim 51 as an example, applicant has not only removed the "virtual device driver" limitation, but rather the "device driver" limitation itself is gone. Instead of having power management by the "virtual device driver", or as originally claimed in claim 11 the "device driver", applicant has included the limitation of "power management software" which is certainly broader than "device driver" or "virtual device driver". So, in this aspect germane to the prior art rejection applicant has certainly broadened the claim beyond not only the "virtual device driver" limitation which was argued as the reason why the claim was allowable over the prior art, but has also broadened beyond the originally filed "device driver" for controlling the power management. Applicant has narrowed the claim with respect to the fact that the devices which are being power managed are "configurable". Examining this situation in light of the court's decision in *Pannu*, applicant has broadened the claim with respect to the very aspect that made the claims allowable over the prior art, i.e. the virtual device driver controlling power management, while narrowing the claim in an aspect that is not material to the prior art rejection, i.e. the addition of the configurable device limitation. Therefore, the claim is not narrowed in any material respect compared with the broadening. As the court held in *Pannu*, applicant is estopped from attempting to recapture the precise limitation added to overcome the prior art rejection. The fact that applicant may have had other limitations that he could have added to overcome the prior art rejection does not bar a recapture rejection.

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With respect to the other independent reissue claims applicant also argues that the various configurability and reconfigurable aspects of the claims are narrowing limitations that are somehow material. However the analysis above also applies to the other independent claims as well. Applicant has broadened the reissue claims by eliminating the precise limitation which he argued made them allowable, while adding limitations that are not material to the prior art rejection.

The dependent reissue claims also fail to include the virtual device driver limitations and thus are also rejected for recapture as it applies to the claims on which they depend.

Applicant alternatively argues that the claims are directed to a totally different invention and these are the "overlooked" aspects that were not originally claimed. Applicant states that the configurable aspect was overlooked and that this ability to manage power to configurable devices is what makes at least claim 51 narrower than the original claims. However, the configurable aspect was present in the original patent at least in claim 35. Therefore the argument that this aspect was overlooked seems to be untrue. Since this aspect was not in fact overlooked in the original patent, even if it were to be found to be materially narrowing, it does not bar a recapture rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (703) 305-9638. The examiner can normally be reached on M-F (8:00 - 5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert W. Beausoliel, Jr. can be reached on (703) 305-9713. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Glenn A. Auve
Primary Examiner
Art Unit 2181

gaa
October 2, 2001